UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,013	10/07/2003	Michael Furst	FURST, M-2	4715

25889 7590 11/15/2006

WILLIAM COLLARD
COLLARD & ROE, P.C.
1077 NORTHERN BOULEVARD
ROSLYN, NY 11576

EXAMINER	
TRAN, THAO T	
ART UNIT	**PAPER NUMBER**
1711	

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/680,013	FURST, MICHAEL	
	Examiner	Art Unit	
	Thao T. Tran	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,8,9,11-13 and 15-31* is/are pending in the application.

4a) Of the above claim(s) *27-31* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,8,9,11-13 and 15-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/16/2006 has been entered.

2. By this Amendment, claims 1, 4, 8-9, 11-13, and 15-31 are currently pending in this application. Claims 5-7 have been canceled. Claims 8-9, 21, and 25 have been amended.

3. Claims 27-30 have been withdrawn as directed to a non-elected invention as indicated in the Office action of 10/14/2005.

4. In view of the prior Office action, the objection of claims 8-9 and the 112 rejection of claims 8-9 have been withdrawn due to the Amendments made thereto. However, the obviousness-type double patenting and the prior art rejections are maintained below.

5. It is noted that a copy of the claims of the corresponding European application has been received on 8/16/2006 and carefully considered.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 4-13, 15-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17, 22-31 of copending Application No. 10/680,012. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims of the copending application is broader than that of the instant claims, rendering them obvious over each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The claims of the copending application disclose all of the limitations as recited in the instant claims. However, the limitations recited in instant claim 1 are disclosed in claims 1-2, 25 of the copending application. Thus, the scope of claim 1 of the copending application encompasses that of instant claim 1, rendering them obvious over each other.

Claim Rejections - 35 USC § 102

8. In view of the prior Office action, the rejection of claims 1, 4-9, 11-13, 15, 17-26 under 35 U.S.C. 102(b) as being anticipated by Rowe (US Pat. 4,396,665) has been withdrawn due to the Amendments made thereto.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 4, 8-9, 11-13, 15, 17-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiercinski et al. (US Pat. 5,687,517).

Wiercinski discloses a roofing underlayment 10, comprising an adhesive layer 12 and a carrier support sheet 14 (see Fig. 1). The adhesive layer 12 is a pressure-sensitive rubberized bitumen adhesive (see col. 5, ln. 22-25). The carrier support sheet 14 comprises at least two film layers that are laminated using an adhesive, with the films formed of different types of polyolefin (see col. 2, ln. 37-57). The roofing underlayment 10 further comprises an oil barrier layer between the carrier sheet 14 and the rubberized bitumen adhesive layer 12. The oil barrier material can comprise polyethylene terephthalate, polyamide, and polyacrylonitrile (see col. 6, ln. 58-64). It is noted that the reference inadvertently made an error by labeling the rubberized bitumen layer as 14 instead of 12.

The roofing underlayment 10 is adhered onto the roof deck 16 by the adhesive layer 12. A peelable release sheet of siliconized paper or release-agent-coated plastic film is used to protect the adhesive layer 12 opposite that of the carrier support sheet 14 before installation (see col. 3, ln. 1-11).

Furthermore, with respect to how the laminate is formed, it has been well settled in the art that it is the structural elements, and not how it is made, would impart patentability when an article claim is being considered. With respect to the thermal coefficients, bonding properties, or other properties, since the reference teaches the same layers of the membrane, the invention of the reference would inherently have the same properties as presently claimed.

11. Claims 1, 4, 8-9, 11-13, 15, 17-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Hamdar et al. (US 2003/0215594).

Hamdar discloses a roofing underlayment, comprising a carrier sheet 22 and an adhesive layer 24 (see Fig. 3; paragraph 0046). The carrier sheet 22 comprises two or more different material layers. One embodiment shows the carrier sheet comprising an uppermost layer of polyethylene and an oil barrier layer between the adhesive layer 24 and the polyethylene film; wherein the oil barrier layer includes polyethylene terephthalate, polyamide, and polyacrylonitrile. The reference also discloses the use of adhesive layers between different sheets or films of the carrier sheet 22 (see paragraph 0065).

The roofing underlayment has a release sheet of siliconized paper to protect the adhesive layer 24 before installation (see paragraphs 0048, 0064).

With respect to how the laminate is formed, it has been well settled in the art that it is the structural elements, and not how it is made, would impart patentability when an article claim is being considered. With respect to the thermal coefficients, bonding properties, or other properties, since the reference teaches the same layers of the membrane, the invention of the reference would inherently have the same properties as presently claimed.

Claim Rejections - 35 USC § 103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiercinski or Hamdar as applied to claims 1 and 15 above, and further in view of Bochow.

Wiercinski and Hamdar are as set forth above and incorporated herein.

Neither Wiercinski nor Hamdar teaches the barrier layer to be lacquer.

Bochow teaches a barrier layer of lacquer in a laminate (see col. 2, ln. 3-8). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed lacquer as the barrier layer, as taught by Bochow, in the laminate of Wiercinski or Hamdar, since it has been a common practice in the art to use lacquer as an alternative for polyamide, polypropylene, or PET layer as a barrier layer.

Response to Arguments

14. Applicant's arguments with respect to the rejections of the claims in the prior Office action have been considered but are moot in view of the new ground(s) of rejection.

15. The obviousness-type double patenting is maintained. Should the claims in this application and the copending application in their final forms are not obvious over each other, the obviousness-type double patenting will then be withdrawn.

Contact Information

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thao Tran

Thao T. Tran
Primary Examiner
Art Unit 1711

tt
November 13, 2006